

REMARKS

This paper is filed in response to the official action dated March 24, 2006. This paper is timely-filed, as it is accompanied by a petition for an extension of time to file in the first month and authorization to charge our deposit account no. 13-2855 the requisite extension fee of \$120.00.

Claims 1-24 are pending. By the foregoing, the specification has been amended to address typographical errors, claims 1, 10, and 23 have been amended to recite "titanium dioxide in an amount from about 20 weight percent to about 60 weight percent," and claims 3, 8, 12, 14, 17, 20, and 22 have been amended to address matters of form. Support for the amendment to claims 1, 10, and 23 may be found, for example, at page 5, lines 13-14. No new matter has been added.

Claims 1-3 have been provisionally rejected for obviousness-type double patenting over claims 1, 3, 5, and 6 of copending and commonly assigned application serial no. 10/756,905. Claims 1-5, 8, 10-14, 23, and 24 have been variously rejected as anticipated by one or more of: JP 59124966, JP 08134387, EP 488980, U.S. Patent No. 6,894,095 to Russo *et al.* ("Russo"), and U.S. Patent No. 4,128,508 to Munden ("Munden"). Claims 1-22 have been variously rejected as obvious over EP 488980, U.S. Patent No. 5,236,987 to Arendt ("Arendt"), and/or JP 08134387.

The various bases for the claim rejections are addressed below in the order presented in the official action. Reconsideration of the application is solicited in view of the present amendments and the following remarks.

CLAIM REJECTIONS – DOUBLE PATENTING

The applicants respectfully traverse the provisional rejections of claims 1-3 for obviousness-type double patenting over claims 1, 3, 5, and 6 of copending and commonly assigned application serial no. 10/756,905.

Obviousness-type double patenting requires the rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a non-prior art, commonly owned patent or patent application. The analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. §103(a) rejection. *See* M.P.E.P § 804 B.1.

Each of the pending claims recites “titanium dioxide in an amount from about 20 weight percent to about 60 weight percent.” None of the claims pending in application serial no. 10/756,905 recites titanium dioxide – in any amount. This difference in claimed subject matter relates to the differences between the two disclosures. The present disclosure is generally directed to correction fluid compositions which change color upon drying whereas application serial no. 10/756,905 is generally directed to eradicating fluids which change color upon drying.

In view of the foregoing, the applicants respectfully submit that claims 1-3 are patentably distinct from the subject matter claimed in application serial no. 10/756,905, and that the provisional double patenting rejections should be withdrawn.

Additionally, the examiner noted that application serial no. 10/756,905 could be applied against the pending claims under 35 U.S.C. §102(e). See official action at page 4. References that qualify as prior art only under one or more of 35 U.S.C. §§102(e), (f), and (g) may not be applied against pending claims in an obviousness rejection when the requisite common ownership is established.

Statement Concerning Common Ownership

The present application and application serial no. 10/756,905 were, at the time the presently claimed invention was made, commonly owned by, or subject to an obligation of assignment to Sanford, L.P.

In view of the common ownership of the presently claimed invention and application serial no. 10/756,905, at the time the later invention was made, application serial no. 10/756,905 may not be applied against the pending claims in an obviousness rejection. See 35 U.S.C. 103(c).

CLAIM REJECTIONS – 35 U.S.C. §102

Claims 1-5, 8, 10-14, 23, and 24 have been variously rejected as anticipated by one or more of: JP 59124966, JP 08134387, EP 488980, U.S. Patent No. 6,894,095 to Russo *et al.* ("Russo"), and U.S. Patent No. 4,128,508 to Munden ("Munden"). The applicants respectfully traverse the anticipation rejections.

It is well-established that each and every limitation of a claimed invention must be present in a single prior art reference in order for anticipation to occur. See, for example, *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir.

1998). The standard for anticipation is one of strict identity. This standard has not been satisfied with respect to claims 1-5, 8, 10-14, 23, and 24, as amended herein.

Each of the pending claims recites a color changing fluid comprising titanium dioxide in an amount from about 20 weight percent to about 60 weight percent. None of the cited documents discloses or suggests such a color changing fluid.

For the foregoing reasons, the applicants respectfully submit that the anticipation rejections of claims 1-5, 8, 10-14, 23, and 24 have been overcome and should be withdrawn.

CLAIM REJECTIONS – 35 U.S.C. §103(a)

Claims 1-22 have been variously rejected as obvious over EP 488980, U.S. Patent No. 5,236,987 to Arendt ("Arendt"), and/or JP 08134387. The applicants respectfully traverse the obviousness rejections.

A *prima facie* case of obviousness must satisfy three legal requirements. First, there must be some suggestion or motivation, either in the references themselves, or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See* M.P.E.P. §2143. These criteria have not been satisfied with respect to pending claims 1-22.

EP 488980 discloses a process for improving the wet hiding power of emulsion paints. EP 488980 explains the problems in prior art emulsion patents by remarking that:

it is necessary to add an excess of titanium dioxide in order to obtain a sufficient hiding power. Titanium dioxide being more expensive than water, there is thus a need in the art for a process for improving the wet hiding power of emulsion paints, more particularly for obtaining substantially equal wet and dry hiding powers.

See EP 488980 at page 2, lines 10-13. Thus, EP 488980 generally teaches against increasing the hiding power of a fluid by using substantial amounts of titanium dioxide. Further, EP 488980 discloses two exemplary paints which comprise five weight percent titanium dioxide. Given the explicit disclosure of an emulsion paint comprising five weight percent titanium dioxide and the implied goal to limit the

amount of titanium dioxide in the emulsion composition, it is respectfully submitted that the pending claims are not obvious over EP 488980, whether taken alone, or in any proper combination with U.S. Patent No. 5,236,987 to Arendt ("Arendt"), and/or JP 08134387.

For the foregoing reasons, the applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, the obviousness rejections of claims 1-22 over EP 488980 have been overcome and should be withdrawn.

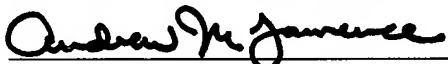
CONCLUSION

It is submitted that the application is in condition for allowance. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, she is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

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